

AMENDMENT UNDER 37 CFR 1.111
Serial No. 09/199,566
Attorney Docket No. 981391

REMARKS

Claims 1 - 40 are pending in the present application. By this Amendment, claims 1 – 40 have been cancelled and new claims 41 – 63 have been added. No new matter has been added. It is respectfully submitted that this Amendment is fully responsive to the Office Action dated October 29, 2004.

Claim Objections:

Claims 1-40 stand objected to on pages 2-4 of the Action due to minor informalities.

However, as stated above, claims 1 – 40 have been cancelled thereby rendering this objection moot.

As to the Merits:

As to the merits of this case, the Examiner sets forth the following rejections:

1) claims 1-27 stand rejected under 35 USC 103(a) based on Watanabe (of record), Sukegawa et al., (of record) Mastercard (of record) and Official Notice;

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2) claims 28-37 stand rejected under 35 USC 103 (c) based on Watanabe, in view of Sukegawa et al., Bradley et al. (of record), Mastercard and Official Notice; and

3) claims 38 and 39 stand rejected under 35 USC 103(a) based on Watanabe in view of Sukegawa et al., Nakamura et al. (of record), and Official Notice; and

4) claim 40 stands rejected under 35 USC 103(a) based on Watanabe in view of Sukegawa et al. and Official Notice.

Each of these rejections is respectfully traversed with regard to the newly added claims 41 – 63.

The present invention at least has the following significant advantages over the cited prior art. Firstly, according to the present invention, even an applicant who lives very far from a passport center issuing a passport is able to obtain a passport using a passport transaction apparatus located at a facility such as a community center, a station, a building, or a convenience store nearest to the applicant. Secondly, an applicant is able to finish together all the various procedures involved in applying for a passport such as obtaining the applicant's certificate of residence, a copy of the applicant's family register, and the applicant's photograph, as well as paying the fees for the various procedures, by just operating the passport transaction apparatus

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without having to actually go to and finish procedures at a plurality of institutions including a passport center, a government office, and various public institutions. Conventionally, to obtain a passport, an applicant living in a countryside has had to spend more than a day to travel to and back from the plurality of institutions. What is more, the applicant has had to withdraw some cash from an ATM or a bank before being able to make the payment for the fees if the applicant happens to be short of cash. Thirdly, not only this convenience but also security is ensured by the automated passport transaction according to the present invention. That is, according to the present invention, by monitoring the person/applicant at the passport transaction apparatus from a remote site such as the passport center, the person operating the passport transaction apparatus can be identified, and crimes around the apparatus can be prevented by detecting any suspicious people or robbers trying to attack the apparatus which handles both cash and important personal data.

To achieve the first and second advantages, the present invention comprises a structure for performing communications with a plurality of institutions which are located at different positions each also different from the position of the passport transaction apparatus. These communications may include the authentication based on the card issued by the financial institution and the code number of the card, verification with the certificate of residence, and payment using the card.

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To achieve the third advantage, the camera for taking the photograph for the passport also has the function as a camera for monitoring the applicant from a site remote from the passport transaction apparatus. By this monitoring function, a passport transaction apparatus remote from a passport center may be utilized conveniently by an applicant living far from the passport center while the security in the passport application is assured even if the passport transaction apparatus is unmanned or fully automated. In contrast, Watanabe, in column 15, lines 27 to 31, discloses that by storing data in the form of electronic images, the face images can be retrieved using the retrieval terminal unit 39 and checked against the applicant, when reissuing of the driver's license is requested because of loss, but Watanabe fails to disclose monitoring the applicant from a remote site using a camera.

Therefore, none of the cited prior art, alone or in combination fails to render obvious a "passport transaction apparatus, comprising: a card processing unit configured to receive a card for an applicant's account at a financial institution, and to read data on the card; a data input unit configured to receive from the applicant input data including at least one of personal information of the applicant, a code number of the card, and a handwritten signature of the applicant, and to input the input data; an image input unit configured to take a photograph of the applicant, and to input an image of the applicant so as to monitor the applicant from a remote site remote from the passport transaction apparatus; a control unit configured to transmit the image input by the image input unit to the remote site via a network, transmit the code number input by the data input unit

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and the data read by the card processing unit via the network to the financial institution; receive registered personal information of the applicant from the financial institution and data related to an official certificate of the applicant from a public institution, when the financial institution identifies the applicant based on the code number and the data transmitted; transmit via the network the registered personal information received or the personal information input by the data input unit and the data related to the official certificate to a passport center which examines passport applications, and communicate with the financial institution to process a payment based on the data read by the card processing unit and the code number input by the data input unit, when a fee for a passport application is to be paid with the card; a passport issuing unit configured to prepare and output a passport using the photograph taken by the image input unit and the handwritten signature input by the data input unit when issuance of a passport to the applicant is allowed by the passport center as a result of the examination; and a cash processing unit configured to receive and provide cash from and to the applicant when the fee is to be paid by cash, wherein the financial institution, the public institution, and the passport center are different institutions," as recited in new claim 41, the corresponding method and system recited in new claims 51 and 54, and the above advantages thereof.

Moreover, it should be noted that a valid obviousness rejection is not simply combining whatever parts called for in a claim and conclude the combination is obviousness. Otherwise, all claims can be rejected by a parts catalog. Section 2143 of the MPEP has specifically stated that:

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“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claimed limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 466, 20 USPQ2d 1438 (Fed. Cir. 1991).”

Therefore, it is both a court position and a Patent Office position that to establish a *prima facie* case of obviousness, 1) there **must be** some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; 2) there **must be** a reasonable expectation of success; and 3) the teaching or suggestion to make the claimed combination and the reasonable expectation of success **must both be** found in the prior art, and not based on applicant’s disclosure.

Therefore, should the Office either be unable to identified each and every aspect of the above-mentioned claimed features after taking full consideration of the asserted prior art in a way exactly applied in the outstanding Office action, or the Office recognizes that the rejection simply does not arise to a level objectively fulfilling all three criteria of establishing a *prima facie* case of obviousness, it is respectfully submitted that the obviousness rejection is defective and allowance of the claimed invention is requested.

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In addition, it is noted that Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be "capable of such instant and unquestionable demonstration as to defy dispute" (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)).

That is, it would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. For example, assertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art. *In re Ahlert*, 424 F.2d at 1091, 165 USPQ at 420-21.

In view of the aforementioned amendments and accompanying remarks, Applicants submit that that the claims, as herein amended, are in condition for allowance. Applicants request such action at an early date.

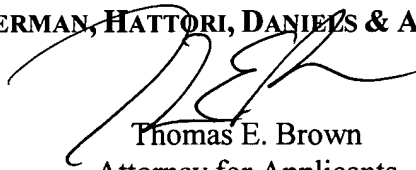
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If the Examiner believes that this application is not now in condition for allowance, the Examiner is requested to contact Applicants' undersigned attorney to arrange for an interview to expedite the disposition of this case.

If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,

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